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REMARKS/ARGUMENTS

Claims 1-3, 5-7, 9-17, 19 and 20 are pending in this application. By this Amendment, Applicant amends claims 1, 2 and 11-13 and cancels claims 4, 8 and 18.

Claims 1-10, 12 and 13 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Applicant has amended claims 1, 2, 12 and 13 to correct the informalities noted by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 1-4 and 6-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Onishi et al. (JP 7-154201). Claims 1, 2, 4, 6, 8-13, 16 and 18-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yamagata et al. (JP 2000-196400). Claims 1, 3-12 and 14-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yuda et al. (EP 1 030 448). Applicant respectfully traverses these rejections.

Claim 1 has been amended to recite:

"A surface acoustic wave filter comprising:

a piezoelectric substrate having an input electrode pad and an output electrode pad;

a plurality of serial surface acoustic wave resonators and parallel surface acoustic wave resonators arranged in a ladder configuration between said input electrode pad and said output electrode pad on said piezoelectric substrate;

a grounded electrode pad connected to at least one of the plurality of parallel surface acoustic wave resonators; and

a grounded electrode pattern directly connected to said grounded electrode pad and arranged on said piezoelectric substrate such that the grounded electrode pad and the grounded electrode pattern surround at least one of said input electrode pad and said output electrode pad on at least three sides thereof; wherein

the grounded electrode pattern is provided between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate." (emphasis added)

Claim 11 has been amended to recite:

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"A surface acoustic wave filter comprising:
a piezoelectric substrate having an input electrode pad and an output electrode pad;
a plurality of serial surface acoustic wave resonators and parallel surface acoustic wave resonators arranged in a ladder configuration between said input electrode pad and said output electrode pad on said piezoelectric substrate; and
a grounded electrode pad connected to at least one of the plurality of parallel surface acoustic wave resonators;
a grounded electrode pattern directly connected to said grounded electrode pad and arranged between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate;
wherein
the grounded electrode pattern surrounds at least one of said input electrode pad and said output electrode pad on at least two sides thereof." (emphasis added)

With the unique combination and arrangement of elements recited in Applicant's claim 1, including the features of "a grounded electrode pattern directly connected to said grounded electrode pad and arranged on said piezoelectric substrate such that the grounded electrode pad and the grounded electrode pattern surround at least one of said input electrode pad and said output electrode pad on at least three sides thereof" and "the grounded electrode pattern is provided between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate," and the unique combination and arrangement of elements recited in Applicant's claim 11, including the features of "a grounded electrode pattern directly connected to said grounded electrode pad and arranged between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate" and "the grounded electrode pattern surrounds at least one of said input electrode pad and said output electrode pad on at least two sides thereof,"

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Applicant has been able to provide a surface acoustic wave filter having a small size (even where the distance between the input/output electrodes is small) wherein attenuation near the pass band on the high-frequency side is greatly improved (see, for example, the first full paragraph on page 4 of the originally filed specification).

The Examiner alleged that each of Onishi et al., Yamagata et al. and Yuda et al. teaches each and every feature recited in Applicant's claim 1, and that each of Yamagata et al. and Yuda et al. teaches each and every feature recited in Applicant's claim 11.

Applicant has amended claim 1 to recite the features of "a grounded electrode pattern directly connected to said grounded electrode pad and arranged on said piezoelectric substrate such that the grounded electrode pad and the grounded electrode pattern surround at least one of said input electrode pad and said output electrode pad on at least three sides thereof" and "the grounded electrode pattern is provided between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate," and have amended claim 11 to recite the features of "a grounded electrode pattern directly connected to said grounded electrode pad and arranged between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is spaced from the edge of said piezoelectric substrate" and "the grounded electrode pattern surrounds at least one of said input electrode pad and said output electrode pad on at least two sides thereof."

In contrast to Applicant's claim 1, as clearly seen in Fig. 1 of Onishi et al., Onishi et al. teaches a grounded electrode pattern 9 which is floating. In other words, the grounded electrode pattern 9 of Onishi et al. is not connected to any grounded electrode pad. Thus, Onishi et al. certainly fails to teach or suggest the feature of "a grounded electrode pattern directly connected to said grounded electrode pad" as recited in Applicant's claim 1.

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In addition, as clearly seen in Fig. 1 of Onishi et al., at best, the grounded electrode pattern 9 of Onishi et al. surrounds **only two** sides of input electrode pad 4. Thus, Onishi et al. clearly fails to teach or suggest the feature of "a grounded electrode pattern ... arranged on said piezoelectric substrate such that the grounded electrode pad and the grounded electrode pattern surround at least one of said input electrode pad and said output electrode pad on **at least three sides** thereof" (emphasis added) as recited in Applicant's claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Onishi et al.

Yamagata et al. (Fig. 2) teaches a grounded electrode pattern 3b which is disposed **on the edge** of the substrate. Thus, Yamagata et al. clearly fails to teach or suggest the feature of "the grounded electrode pattern is provided between at least one of said input electrode pad and said output electrode pad and an edge of said piezoelectric substrate, such that the grounded electrode pattern is **spaced from the edge** of said piezoelectric substrate" (emphasis added) as recited in Applicant's claim 1, and similarly in Applicant's claim 11.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 11 under 35 U.S.C. § 102(b) as being anticipated by Yamagata et al.

Yuda et al. (Fig. 15) teaches three separate and distinct grounded electrode patterns (not numbered), each of which are, at best, adjacent to **only one side** of the input/output electrode pads of input/output terminals 22, 23. Particularly, the grounded electrode pattern disposed in the lower left-hand corner of the filter shown in Fig. 15 of Yuda et al. is adjacent to **only one side** of the input electrode pad, the grounded electrode pattern disposed along the top of the substrate of the filter shown in Fig. 15 of Yuda et al. is adjacent to **only one side** of the input electrode pad and **only one side** of the output electrode pad, and the grounded electrode pattern disposed in the lower right-hand corner of the filter shown in Fig. 15 of Yuda et al. is, at best, adjacent to **only**

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one side of the output electrode pad. Thus, Yuda et al. clearly fails to teach or suggest the feature of "a grounded electrode pattern ... arranged on said piezoelectric substrate such that the grounded electrode pad and the grounded electrode pattern surround at least one of said input electrode pad and said output electrode pad on **at least three sides** thereof" (emphasis added) as recited in Applicant's claim 1, and the feature of "the grounded electrode pattern surrounds at least one of said input electrode pad and said output electrode pad on **at least two sides** thereof" (emphasis added) as recited in Applicant's claim 11.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 11 under 35 U.S.C. § 102(b) as being anticipated by Yuda et al.

Accordingly, Applicant respectfully submits that Onishi et al., Yamagata et al. and Yuda et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicant's claims 1 and 11.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1 and 11 are allowable. Claims 2, 3, 5-7, 9, 10, 12-17, 19 and 20 depend upon claims 1 and 11, and are therefore allowable for at least the reasons that claims 1 and 11 are allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a One-month extension of time, extending to February 22, 2005 (February 19, 2005 is a Saturday, and February 21, 2005 is a federal holiday), the period for response to the Office Action dated October 19, 2004.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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